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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/826,604

04/16/2004

Aaron Hobart

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EXAMINER

AFTERGUT, JEFF H

ART UNIT

PAPER NUMBER

1791

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DELIVERY MODE

11/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/826,604

Applicant(s)

HOBART, AARON

Examiner

Jeff H. Aftergut

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 8-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 18-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-3, 6, 7, 18-20, 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Nishanen for the same reasons as presented in paragraph 2 of the Office action dated June 5, 2007.
3. Claims 4 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 2 further taken with Fujiwara for the same reasons as presented in paragraph 3 of the Office action dated June 5, 2007.
4. Claims 5 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 3 further taken with Gangemi for the same reasons as expressed in paragraph 4 of the Office action dated June 5, 2007.
5. Claims 2, 3, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 2 further taken with Rodriguez et al for the same reasons as expressed in paragraph 5 of the Office action dated June 5, 2007.
6. Claims 4 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 3 further taken with Rodriguez for the same reasons as set forth in paragraph 6 of the Office action dated June 5, 2007.
7. Claims 5 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 4 further taken with Rodriguez for the same reasons as set forth in paragraph 7 of the Office action dated June 5, 2007.

Election/Restrictions

8. Claims 8-17 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12-7-06.

Response to Arguments

9. Applicant's arguments filed October 3, 2007 have been fully considered but they are not persuasive.

The applicant is advised as an initial matter that the "Petition to Invoke Supervisory Intervention" which applicant indicated was being submitted with the response has not been submitted and is not of record in the Office. As for the inappropriateness of the new second action non-final and an explanation as to why the previous rejection was being withdrawn, applicant is referred to page 8 of the previous Office action where it was expressly stated:

"The applicant is advised that Gangemi did not apply the adhesive material directly onto the core and this is the reason for the new ground of rejection."

Additionally, it should be noted that the last Office action was not made final. Applicant is also advised that in every application subsequent to an Office action it is necessary for the examiner to update the field of search and to not update the search would have been an error in the examination process. Any additional burden applicant has been subjected to by the purported "conducting of piecemeal examination" is respectfully regretted.

As to the arguments, the applicant argues that the admitted prior art had no knowledge of the unsolved problem associated with the present invention. The applicant

is advised in this regard that the field of endeavor relates not only to the formation of a roofing membrane but also to the manner in which one wound the membrane up for storage after manufacture. The field of endeavor is therefore not so limited as to be solely in the art of roofing membrane manufacture but rather it related to useful ways that one skilled in the art would have provided for the take up of endless webs of material wherein such materials were gathered on cores in roll form. Note that the claims are apparatus claims and that the material worked upon in an apparatus claim is given little or no weight and thus the field of endeavor relates to useful ways one skilled in the art could efficiently gather an endless web on a core.

The applicant argues that like the admitted prior art, the reference to Nishanen failed to teach or suggest a mandrel disposed "proximal to an output region of the finishing product winding machine and adapted to receive a core". This is not well taken. The admitted prior art suggested that in the current state of the prior art paper cores were manually fitted onto the mandrel of the finished product winder (see paragraph [0006]. The admitted prior art clearly envisioned that one skilled in the art would have disposed the cores upon a mandrel which was disposed proximate the output region of the finishing product winding machine. The modification being made here is not to force fit the arrangement of Nishanen onto the admitted prior art, but rather to adapt the admitted prior art with the means necessary to facilitate quick and efficient wind up of the material onto the cores (rather than requiring intervention by the worker to apply tape to the cores on the mandrels of the known wind up machines of the admitted prior art). The applicant seems to think that the adaptation of the device would eliminate the

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use of the hold down tube 20 in the device, however, inclusion of a mandrel for the core would merely provide a means to support the core in Nishanen and nothing more. There is no need to exclude the depression tube 20 as argued by applicant and moving the same adjacent the exit of the finishing operation would not require elimination of the same. The argument is not persuasive.

The applicant also noted that the combination failed to teach a guide to guide the leading edge of the membrane to the core. This likewise is not persuasive. The applicant described roller guides 64 which guide the web to the mandrel and core. There is no other "guide" structure defined in the disclosure which structure was recited for guiding the web leading edge to the adhesive coated core. In this regard, the reference to Nishanen taught the use a roller 18 which was used to feed (guide) the paper to the coated core in the winding operation. Clearly, Nishanen taught the use of a guide which indexed the leading edge of the paper (the material being worked upon) to the core. As addressed above, the material being worked upon is of little import to the patentability of the apparatus claims as the material worked upon does not constitute part of the apparatus.

The applicant argues that a prima facie case has not been established because components of the claimed device were not found in the prior art (the admitted prior art or Nishanen). However, as addressed above, the references clearly taught those features which applicant stated were lacking from the prior art. The argument that a prima facie case has not been established is therefore not persuasive. The applicant argues additionally in this regard that there is no motivation to combine the references.

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The Office takes issue with this statement. Clearly, in order to more quickly and efficiently changeover in the take up of the web material, one would have been motivated to eliminate the hand taping of the material to the cores and provided the adhesive dispensing operation of Nishanen as discussed previously. The reference clearly suggested that the application of glue onto the cores was desirable as it would have allowed for easy take up of the material on the cores. The artisan working in the gathering and take up of material onto cores would have been aware of the need to facilitate mechanical means to replace the hand labor of taping the edge and would have been motivated to look to the teachings of Nishanen. One would have been motivated to practice the claimed invention for these reasons.

Applicant notes that the secondary references to any one Fujiwara, Gangemi and Rodriguez failed make up for the deficiencies of the references applied to the admitted prior art and Nishanen. However, as expressed above, no such deficiencies exist. It is therefore believed that the rejection should be sustained. It should be noted that other than stating that these references did not make up for the deficiencies of the admitted prior art and Nishanen, the applicant did not address any of the teachings of these references for what they were applied for. Applicant therefore acquiesced to the teachings of these references for what they were applied for.


No claims are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 571-272-1212. The examiner can normally be reached on Monday-Friday 7:15-345 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jeff H. Aftergut
Primary Examiner
Art Unit 1791

JHA
October 31, 2007